

Reconsideration of the above-identified application is respectfully requested in view of the following amendments and remarks.

REMARKS

Applicant wishes to thank the Examiner for the telephone interview granted on October 9, 2007. During the interview the Examiner indicated that she would reconsider the Rule 131 Declaration previously submitted, and that the finality of the Final Office Action issued on July 9, 2007, would be withdrawn.

Status of the Claims

Claims 17-29 are currently pending. Claims 17-29 have been rejected.

Rejections under 35 U.S.C. § 103

The Examiner has rejected claims 17, 19-21 and 23-29 under 35 U.S.C. §103(a) as being unpatentable over Zhang (U.S. Pat. No. 6,528,086). Applicant respectfully traverses this rejection.

Claim 17 is directed to, “[a] method of treating immunological skin disorders comprising applying onto an area of skin affected by said skin disorder a fluid, film-forming carrier having contained therein a steroid, and hardening the carrier into a tangible, member juxtaposed to said affected area.” See Claim 17 (emphasis added). Zhang et al. discloses a wide variety of useful drugs which may be applied to the skin using the drug delivery method of Zhang et al. Although, Zhang et al. does disclose the use of a corticosteroid as a potential anti-inflammatory agent, Zhang et al. does not specifically disclose the use of a film-forming carrier containing a steroid in a method to treat immunological skin disorders. As such, it is Applicant’s position that

one of skill in the art would not know to combine a steroid and film-forming carrier to treat immunological skin disorders without the benefit of Applicant's Specification.

As such, Applicant respectfully asserts that Zhang et al. does not and cannot render claim 17 obvious.

Nevertheless, in the interest of expediting prosecution, Applicant previously submitted the Declaration of Joel R. Studin under 37 C.F.R. § 1.131 (see Reply filed April 11, 2007), showing the preparation and use of Scar Guard in the treatment of skin disorders, such as psoriasis. As the Declaration points out, Exhibit A shows the formulation of Scar Guard, which contains a corticosteroid in a film-forming carrier, and Exhibit C shows the testing of Scar Guard on psoriasis, both prior to September 28, 1999, the earliest filing date of Zhang et al. See the Declaration of Joel R. Studin at paragraphs 5-7. According to M.P.E.P., “[t]he 37 CFR 1.131 affidavit or declaration must establish possession of either the whole invention claimed or something falling within the claim (such as a species of a claimed genus). See M.P.E.P. 715.02 (emphasis added). Furthermore, “[a] reference of activity applied against generic claims may (in most cases) be antedated as to such claims by an affidavit or declaration under 37 CFR 1.131 showing completion of the invention of only a single species, within the genus, prior to the effective date of the reference.” See M.P.E.P. 715.02 II. As such, Applicant respectfully asserts that Zhang et al. is no longer an effective reference against the invention as claimed. In as much as the Applicant has reduced the present invention to practice prior to the effective date of the Zhang et al. reference, Zhang et al. is no longer an effective reference against the invention as claimed.

However, according to the Examiner, the Declaration is insufficient because it “does not demonstrate a data comparison between the closes prior art and that of the

instant invention.” See Final Office Action at page 8, first paragraph. As Applicant pointed out to the Examiner in a telephone conversation on October 9, 2007, the Declaration submitted with the Reply on April 11, 2007, was not intended to show unexpected results. Rather, the Declaration was submitted to antedate the Zhang et al. reference. As such, the Rule 131 Declaration is proper and any rejection based on Chang et al. is improper. The Examiner admitted in the telephone conversation of October 9, 2007, that she did not properly consider the Rule 131 Declaration and has kindly agreed to reconsider the Rule 131 Declaration of Joel R. Studin.

Claim 19 is directed to “[a] composition for treating adverse skin conditions comprising a fluid, film-forming carrier and an active ingredient comprising a topically active steroid or, a silicone-gel or mixture thereof, said carrier capable of hardening to a tangible member.” See claim 19 (emphasis added). Again, Applicant respectfully directs the Examiner’s attention to the Declaration of Joel R. Studin under 37 C.F.R. § 1.131 submitted on April 11, 2007, which shows the preparation of Scar Guard prior to September 28, 1999, the earliest priority date of Zhang et al. As Applicant has mentioned hereinabove, the Declaration shows the formulation and testing of Scar Guard, which contains a corticosteroid and a film-forming carrier, prior to September 28, 1999. See the Declaration of Joel R. Studin at paragraphs 5-7. According to M.P.E.P., “[t]he 37 CFR 1.131 affidavit or declaration must establish possession of either the whole invention claimed or something falling within the claim (such as a species of a claimed genus). See M.P.E.P. 715.02 (emphasis added). Furthermore, “[a] reference of activity applied against generic claims may (in most cases) be antedated as to such claims by an affidavit or declaration under 37 CFR 1.131 showing completion of the invention of only a single species, within the genus, prior to the effective date of the reference.” See M.P.E.P. 715.02 II. As such,

Applicant respectfully asserts that Zhang et al. is no longer an effective reference against the invention as claimed.

As such, Applicant asserts that the presently claimed invention is not, and cannot be, rendered obvious by Zhang et al. Reconsideration and withdrawal of this rejection are respectfully requested.

The Examiner has rejected claims 18 and 22 under 35 U.S.C. §103(a) as being unpatentable over Zhang (U.S. Pat. No. 6,528,086) in further view of Herb et al. (U.S. Pat. No. 5,534,246). Applicant respectfully traverses this rejection.

Herb et al. also teaches that nonvolatile organic compounds, such as phenyltrimethicone can also be added to the compositions to provide an aesthetic effect of for adjusting the refractive index (col. 12, lines 41-54); (Claims 20 & 35)." See Final Office Action at page 6, fifth paragraph. The Examiner then concludes "[i]t would have been obvious to one of ordinary skill in the art at the time the invention was made to incorporate the dermatitic/psoriatic medications and phenyltrimethicone organic compound as taught by Herb et al. within the delivery formulation of Zhang." See Final Office Action at page 6, third paragraph.

As mentioned hereinabove, Applicant previously submitted the Rule 131 Declaration of Joel R. Studin, which shows the preparation and testing of Scar Guard prior to September 28, 1999, the earliest priority date of Zhang et al. See the Declaration of Joel R. Studin at paragraphs 5-7 file with the Reply of April 11, 2007. As mentioned hereinabove, the Examiner agreed in a telephone conversation on October 9, 2007 to reconsider the Rule 131 Declaration. Applicant respectfully assert that the Declaration shows that the Applicant had reduced the present invention to

Joel R. Studin
Serial No. 10/829,315

practice prior to the effective date of the Zhang et al. reference, and thus, Zhang et al. is no longer an effective reference against the invention as claimed.

Furthermore, Herb et al. does not teach or suggest all the claim limitations of the presently claimed invention. Specifically, Herb et al. does not teach or suggest the use of a topically effective steroid in a film-forming carrier. As such, Herb et al. alone is insufficient to render the presently claimed invention obvious. Applicant asserts that the presently claimed invention is not, and cannot be, rendered obvious by the combination of Zhang et al. and Herb et al.

Reconsideration and withdrawal of this rejection are respectfully requested.

Respectfully submitted,

Oct 9, 2007
Date


Phillip R. Kiefer
Reg. No. 55,326

Frenkel & Associates, P.C.
3975 University Drive, Suite 330
Fairfax, VA 22030
Telephone: (703) 246-9641
Facsimile: (703) 246-9646